REMARKS

In reply to the Office Action mailed October 22, 2004, Applicants amended claims 1, 6-8, and 11, and cancelled claims 2-4 and 9-10. Claims 1, 5-8, and 11 are presented from examination.

Election/Restrictions

Applicants elected Group II and Example 365 in our prior Reply to Restriction requirement. It appears as though the Examiner has mistakenly characterized Applicants' elected species. Although the Examiner asserts that the elected species corresponds to n equaling zero, the elected species N- (1-benzyl-4-piperidinyl)-3-[3-(2-pyridinyl)-1,2,4-oxadiazol-5-yl] propanamide actually corresponds to an n of 2.

35 U.S.C. § 101

Claims 9 and 10 were rejected under 35 U.S.C. § 101 as purportedly lacking utility. Claims 9 and 10 were cancelled, so the rejection should be withdrawn.

35 U.S.C. § 112, second paragraph

Claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as purportedly being indefinite.[1] The Examiner has identified four items that purportedly render the claims indefinite, points (A), (B), (C), and (D).

The Examiner is reminded that, as stated by the United States Court of Appeals for the Federal Circuit in *Orthokinetics, Inc., v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986):

> A decision on whether a claim is invalid under § 112, 2d ¶, requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.

Here, Applicants have clearly satisfied this requirement.

[1] Claims 2-4 have been cancelled, so the rejection of these claims should be withdrawn.

With respect to point (A), Applicants amended the claims to remove the term "optionally" before the number of carbon atoms that form carbonyl groups and before the number of ring heteroatoms. Thus, as amended, the claims cover ring systems which can have up to two ring carbon atoms that form carbonyl groups and up to four ring heteroatoms that are independently selected from nitrogen, oxygen and sulphur. Applicants believe that, in light of the specification, one skilled in the art would readily understand what is claimed in this regard.

Regarding point (B), the Examiner stated (Office Action at 3):

> "Claim 1 recites R1, R6 and other variables (where applicable) as:" heterocyclyl, heterocyclllyloxy", the claim does not exactly state nature of heterocycle, ring size, number of heteroatoms in a ring, exact arrangement of the heteroring, and exact point of attachment to the carbon atom of the main core."

But, the claims explicitly recite the size of the ring (three to 14 members) and the number of heteroatoms in the ring (up to four), and one skilled in the art would clearly understand this. Further, the Examiner seems to be attempting to require Applicants to include "exact" limitations in the claims. Applicants are unaware of any such *per se* requirement, and, should the Examiner maintain the rejection on these grounds, Applicants request the Examiner to provide appropriate legal support for this position. Applicants believe that, as noted above, the correct legal standard relates to whether, in light of the specification, one skilled in the art would understand what is claimed. Here, one skilled in the art would readily understand the subject matter claimed in light of the specification. If the Examiner believes to the contrary, the Examiner should provide a proper factual basis for this position.

Applicants amended the claims to address points (C) and (D) in the manner indicated by the Examiner, so the rejection relating to these points should be withdrawn.

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 112, first paragraph

Claim 10 was rejected under 35 U.S.C. § 112, first paragraph, as purportedly lacking enablement. However, it appears from the Examiner's discussion that the rejection is actually directed to claim 11. Applicants cancelled claim 10 and amended claim 11 to be limited to asthma, as indicated by the Examiner. Applicants therefore request reconsideration and withdrawal of this rejection.

35 U.S.C. § 102/§ 103

Claims 1-7 were rejected under 35 U.S.C. § 102(b) as purportedly being anticipated by Inaba *et al.* JP 10259176 ("Inaba") and Takasugi *et al.* WO 9313083 ("Takasugi"), and were further rejected under 35 U.S.C. § 103 as purportedly being unpatentable over Inaba and Takasugi.[2]

Claims 1 and 5-7 cover compounds that feature a piperidine connected through a propanamide to a heterocyclic moiety. In contrast, both Inaba and Takasugi disclose a piperidine connected directly through an amide linkage to a heterocyclic moiety. (See e.g., Inaba RN 214846-51-2 and Takasugi RNs 151097-86-8, 151097-87-9, 151307-60-7) Thus, for at least this reason, neither Inaba nor Takasugi disclose the compounds covered by claims 1 and 5-7.

Moreover, the Examiner has not suggested a motivation to modify either Inaba or Takasugi to include a propanamide linkage rather than the disclosed amide linkage. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation for the proposed modification of the reference. Without evidence of such a motivation, a *prima facie* case of obviousness cannot be maintained.

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102(b) and 103.

[2] Claims 2-4 have been cancelled, so the rejection of these claims should be withdrawn.

Applicants believe the application is in condition for allowance, which action is requested. Applicants submit herewith a Petition for a Three Month Extension for responding to the Office Action, along with a check to cover the associated fee. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: April 22, 2004

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